

REMARKS

Claims 1-3 are pending in this application. Applicant wishes to thank the Examiner for the indication of allowance of claims 1-2. Claim 3 stands rejected under 35 U.S.C. § 103(a). In light of the remarks set forth below, Applicants respectfully submit that all of the pending claims are in immediate condition for allowance.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,157,622 ("Tanaka") in view of U.S. Patent No. 5,088,091 ("Schroeder") in view of U.S. Patent No. 6,697,359 ("George"). Applicants respectfully request reconsideration and withdrawal of this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See, In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicants.

The present rejection runs afoul of a basic mandate inherent in § 103-that "a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure" shall not be the basis for a holding of obviousness. In re Rothermel, 47 CCPA 866, 870, 276 F.2d 393, 396, 125 USPQ 328, 331 (1960). "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art."

See In re Wesslau, 353 F.2d 238, 241, 147 USPQ 391, 393 (1965). See In re Vogel, Lamb, and Palmer, 150 USPQ 445, 363 F2d 459 (CCPA 1966).

The Office Action utilizes three references in the rejection, one reference to disclose each one of the three limitations recited in Applicants' claim. Applicants respectfully assert that the explicitly recited limitations in claim 3 are not disclosed in the cited reference and that there is no motivation to combine these three references.

The invention recited in claim 3 is a addressing method for communication, comprising: at least one calculation type address having bits "1" corresponding to destinations to which a multicast packet is to be transferred; at least one directional route mask having bits "1" corresponding to those directional routes into which a multicast packet is to be transferred; and at least one terminal mask having a bit "1" corresponding to that destination which is to receive the multicast packet.

By using the calculation type address so as to represent the information of the destination group to which the multicast communication is conducted, by using the directional route mask so as to represent the directional route information of the destination to which the multicast communication is conducted, and by using the terminal mask so as to represent the information for identifying whether the pertinent terminal is the destination of the multicast communication; those routers on the way of the route of the multicast are to route the multicast packet to that directional route given with the logical product of "1" by the combination of the information of the calculation type address and the information of the directional route mask, while the destination receives a multicast packet given with the logical product of "1" by the combination of the information of the calculation type address and the information of the terminal mask; to drastically reduce the amount of information to be held and managed.

The Office Action asserts that the claimed calculation type address having bits (1) corresponding to destinations to which a multicast packet is to be transferred is disclosed in Tanaka at column 1, lines 60-64, and that it would inherently use bits (1) to indicate the destination. Applicants respectfully disagree.

In Tanaka, a generation section 320 calculates a multicast address according to terminal addresses of each destination terminal stored in the terminal information memory section. There is no disclosure, and it is not inherent, that there is at least one calculation type address having bits "1" to indicate destinations. As such, this limitation is not disclosed by Tanaka. Tanaka merely generates a multicast address attached to a communication sentence as a packet header. There is no disclosure of "at least one calculation type address having bits "1" corresponding to destinations to which a multicast packet is to be transferred" as recited in claim 3.

The Office Action recognizes that the remaining two limitations in Applicants' claim are not present in Tanaka. The Office Action proceeds to include Schroeder and George to meet the limitations recited in Applicants' claim. The Office Action asserts that it would have been obvious to one skilled in the art at the time of the invention to combine these references because it would "give the routers in the system extra information to use in the routing of packets." See Office Action at 3. However, this motivation to combine fails as a matter of law.

When making an obviousness determination, the prior art must provide a suggestion or motivation to combine the references. Absent this suggestion or motivation, the mere existence of the individual elements at the time of the invention does not render a patented combination of these elements obvious as a matter of law. See, Remcorp Products Co. v. Scottsman Group, Inc., 32 U.S.P.Q.2d 1273, 1279 (N.D. Ill. 1994). While the separate limitations of a claim can appear in various combinations in the prior art, a claim is not obvious if there is no suggestion for combining the

references. There must be some suggestion, motivation or teaching in the prior art whereby the person of ordinary skill would have selected the components that the inventor selected and use them to make the new device. See, Go Lite, Inc. v. Walmart Stores, Inc., 69 U.S.P.Q.2d 1481, 1488 (Fed. Cir. 2004). Here, there is no suggestion or motivation in the prior art to combine all three references.

No suggestion or motivation exists in any of the references to combine all three references. There is no motivation to make the two-fold modification of Tanaka, to first modify Tanaka in light of Schroeder and then to further modify the combination of Tanaka and Schroeder in view of George. This motivation or suggestion does not exist in the references. As discussed above, merely because each element of a claim is known, it does not render the claim obvious. Here, there is no motivation to combine these three references. As such, Applicants respectfully submit that claim 3 is allowable.

Applicants have responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Application No.: 09/851,302

Docket No.: I3117.0026

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

Dated: December 6, 2005

Respectfully submitted,

By 

Ian R. Blum

Registration No.: 42,336

DICKSTEIN SHAPIRO MORIN & OSHINSKY
LLP

1177 Avenue of the Americas
New York, New York 10036-2714
(212) 835-1400
Attorney for Applicant

IRB/mgs